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| 30678 7590 12/18/2008 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006 | | | | |
| EXAMINER | | | | |
| ORLANDO, MICHAEL N | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,582

Applicant(s)

MEBBERSON ET AL.

Examiner

MICHAEL N. ORLANDO

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/18/2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-71 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 63-68 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 69-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/CIS)
Paper No(s)/Mail Date 09/18/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

The arguments and amendments submitted 09/18/2008 have been fully considered, but are unpersuasive. The claims remain unpatentable over the prior art as set forth below.

Election/Restrictions

1. Newly submitted claims 69-71 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The method of applying the film is fundamentally different than the apparatus for applying the film as was the grounds for the original restriction. The applicant seeks to reintroduce the previously restricted method. The apparatus can be used in materially different methods such as one in which the film is conveyed rather than the corks and such as one which the end face is not exposed. The intended use of the device is not limiting and the device to which the applicant claims is capable of applying the film to other faces which are not the end face. Also, the method could have been performed with a different apparatus such as one which has separate cutting and disc applying stations or one which does not possess carriages.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 69-71 are withdrawn from consideration

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 63-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2003/0102283) in view of McLaughlin (US 2,782,815) and Johnson (GB 420,628).

Regarding claim 63, Fox discloses a cork that has endcaps of a film whereby the film can be cut from a sheet and then applied to the ends of the cork through methods such as heat sealing or hot melt adhesives (figure 1; [0044]-[0047]).

Fox fails to explicitly teach an apparatus, which has various stations performing the activities set forth above and fails to teach the corks being conveyed past a web cutter via carriages for bonding and curing.

Firstly it is reiterated that Fox discloses the acts of cutting the end films for application to cork from a sheet, applying the end film and adhering the film via various process such as thermal welding or hot melt adhesive (i.e. heat and pressure). It is obvious many adhesion means would need a setting (i.e. curing) and if a hot melt adhesive was heated to a flowable form as the adhesion means, it would clearly need to be cooled back down (i.e. cured) in order to facilitate the bond. If a thermal welding was used to bond the film it would likewise require a cooling period to set and cool to a useable form. If an adhesive rather than thermal welding it is utilized it is noted that the particular nature of the adhesive employed, its composition, and/or physical properties would have been obvious to one having ordinary skill in the art based on considerations of cost, availability, bond strength, mode of application or environmental preference. Typically, selection of the proper adhesive may be achieved in the course of routine experimentation, by reference to standard technical literature (e.g., Adhesive Age trade magazine, Adhesive Handbook), or through consultation with industrial or specialty

adhesive suppliers (e.g. Dupont, Dura, Loctite, Lord, etc.). As to the introduction of broad automated means for merely performing the same process of Fox it is noted that such is obvious to an ordinary skilled artisan for reasons of decreasing human error and increasing manufacturing efficiency. Also, note that the courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

As to the grooved carriages Johnson provides a cork processing apparatus whereby it discloses that the apparatus utilizes recesses for feeding caps laterally (page 3, lines 75-90). It would have therefore been obvious to one having ordinary skill in the art to have utilized an apparatus with recesses in view of Johnson because such would have provided the obvious advantage of stabilizing the movement of the cork and allowing it to be facilitated down a conveying means in an organized manner for processing. Alternatively, McLaughlin discloses another cork processing apparatus whereby it is also taught to utilize pockets or recesses in order to receive the stoppers in order to carry and position them (column 1, line 74 – column 2, lines 36). It would have therefore also been obvious to utilize recesses in view of McLaughlin because it was well known in the art of cork stopper processing to use recesses with such recesses providing the obvious advantage that they can be used to facilitate movement along a conveying means and can be used in order to ensure proper placement of the corks.

Regarding claim 64, as discussed above the heating and cutting means are disclosed by the prior art. Combining the cutting device and heating unit into one unit is

an obvious matter because it does nothing more than combine known elements according to known methods in order to yield predictable results. An ordinary skilled artisan would have been motivated to combine said prior art elements in order to yield the predictable result of performing the same functions in one station rather than two which leads to a reduction in complexity and/or size of the system (i.e. combine two stations into one). It is noted that the ends caps of Fox correspond to a cork which has a cylindrical shape and therefore capping the ends amounts to the addition of a disc shaped portion of film. It is also noted though the shape of the film is not patentably distinguishable since its ability to provide an oxygen barrier is taught by Fox and an ordinary skilled artisan would have been able to shape the film as desired in order to control the oxygen permeation through the cork as desired.

Regarding claim 65, as discussed above Fox discloses the film. Whether or not the film is spooled is not patentability distinguishing so long as the film is used in the same manner (i.e. applied to the end faces of the cork). The spooling does nothing more than change the shape and the courts have continually held that changes in shape and/or proportion is not patentably distinguishing features (*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976)). Though a change in shape requires only routine skill, an ordinary skilled artisan would have been motivated to make such a change in order to predictably conserve space (a spooled film would take up less area than a spread out film of equal size).

Regarding claim 66, as noted above if a hot melt and/or thermal welding are used the curing and subsequent usable product would require cooling. Also it is noted that Johnson discloses that in the practice of applying hot melt adhesive to corks it was known that the adhesive may be added followed by a heating means to make the adhesive viscous and a cooling means to set the adhesive (column 1, lines 25-35). If an adhesive rather than thermal welding it is utilized it is noted that the particular nature of the adhesive employed, its composition, and/or physical properties would have been obvious to one having ordinary skill in the art based on considerations of cost, availability, bond strength, mode of application or environmental preference. Typically, selection of the proper adhesive may be achieved in the course of routine experimentation, by reference to standard technical literature (e.g., Adhesive Age trade magazine, Adhesive Handbook), or through consultation with industrial or specialty adhesive suppliers (e.g. Dupont, Dura, Loctite, Lord, etc.). The nature of the curing system is therefore dependent on the adhesion system and it would have been within the level of ordinary skill to utilize the necessary curing procedure for a given adhesive process (i.e. UV, heat, cooling, moisture, pressure etc.).

5. Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2003/0102283), McLaughlin (US 2,782,815) and Johnson (GB 420,628), as applied above, and further in view of Coningsby (US 6,220,154).

Regarding claim 67 and 68, the merits have been substantially addressed above. The recesses are discussed above and note that the positioning of the cork in the recesses with the end faces exposed is obvious since Fox would need the end face to

be exposed so as to apply the film to said faces. It is noted that a hopper would have been well known across many arts and would have been incorporated in order to create a supply chamber for the corks so that they may be fed through the system. Even though such are well known across many arts the examiner specifically notes that they are also known in the art of cork processing.

Coningsby, drawn to a cork processing apparatus, discloses a hopper for containing the corks prior to processing so that they may be fed into the general system for processing (figure 1, chamber 106). It would have been obvious to one having ordinary skill in the art to have utilized such a hopper in view of Coningsby in order to create a self-sustaining system for the corks whereby the hopper is simply fed with a bulk supply of cork and the apparatus can proceed without the necessity for manual loading onto a conveying means.

Response to Arguments

6. Applicant's arguments with respect to claims 63-68 have been considered but are moot in view of the new ground(s) of rejection.

The applicant's primary contention is in the automation of the process.

The mere automation of the process is not taken as a distinguishing feature and is not a persuasive argument as to the patentability of the apparatus. The courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 09/18/2008 also prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL N. ORLANDO whose telephone number is (571)270-5038. The examiner can normally be reached on Monday-Thursday, 7:30am-4:30pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MO

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791